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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/974,653	10/10/2001	Andrew D. Bicek	760-49	9912

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EXAMINER
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NGUYEN, VI X

ART UNIT	PAPER NUMBER
3731	

DATE MAILED: 06/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/974,653	Applicant(s) BICEK ET AL.	
	Examiner Victor X Nguyen	Art Unit 3731	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2004.
- 2a) ☒ This action is FINAL.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 17-24 and 39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-24 and 39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

1. This application contains claims 1-16,25-27 and 28-38 drawn to non-elected inventions. In December 2, 2003, applicant elected to prosecute Species II of Group III that associated with fig. 5 **without traverse**. Furthermore, Applicant has stated that all claims 17-27 read upon the elected species. However, claims 1-16,25-27 and 28-38 do not read upon the elected species. Therefore, non-elected claims 1-16,25-27 and 28-38 are withdrawn from further consideration.

The requirement is deemed proper and is therefore made **Final**.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 17-24 are rejected under 35 U.S.C. 102 (e) as being anticipated by Davila et al (U.S. 6,296,661).

Regarding claims 17-20 and 39, Davila et al disclose in figs 6-9, a stent graft for insertion into target site within a vessel of a patient, including: a main stent (80) has a radially-expandable body, at least one support stent (60), and a sheath (104) between the body, and the support stent where no portions of the main stent are in contact with the support stent, and the sheath is not bonded to the support stent. Note that the support stent (60) is capable of producing a force with the stent to hold the sheath (104) in place. The statement of intended use and other functional

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statements have been carefully considered but are deemed not to impose any structural limitations on the claims distinguishable over Davila et al which is capable of being used as claimed if one desires to do so.

Regarding claims 18-20, Davila et al disclose the support stent (60) is superelastic alloys (see col. 5, lines 24-32). The sheath (104) disposes radially outwardly or inwardly of the stent.

Regarding claims 21-22, Davila et al disclose the support stent has an axial length which is less than the axial length of the body (fig. 6, see col. 5, lines 21-25).

Regarding claims 23-24, Davila et al disclose sheath is selected from the group consisting of a polymeric/a biomaterial sleeve (see col. 9, lines 25-38). The sheath is also treated with a drug selected from the group consisting of biocompatible material (see col. 3, lines 4-25).

### ***Response to Arguments***

3. Applicant's arguments filed 3/30/2004 have been fully considered but they are not persuasive. With respect to claim 17, the examiner disagrees with applicant's remarks that there is no disclosure in Davila et al to rely on any pressing force generated by the inner and outer stents to hold the graft in place. As the examiner has pointed out above, Davila et al disclose in figs 6-9, a stent graft for insertion into target site within a vessel of a patient, including: a main stent (80) has a radially-expandable body, where at least one support stent (60) and a sheath (104) come between the body. The support stent with no portions of the main stent are in contact with the support stent. Note that the support stent (60, best view in figs. 6 and 9e) is capable of producing a force with the stent to hold the sheath (104) in place. The statement of intended use and other functional statements have been carefully considered but are deemed not to impose any structural limitations on the claims distinguishable over Davila et al which is capable of being

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used as claimed if one desires to do so. Therefore, at least claim 17 of the invention is not defined over the Davila et al '661 reference.

***Conclusion***

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor X Nguyen whose telephone number is (703) 305-4898. The examiner can normally be reached on M-F (8-4.30 P.M).

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Victor X Nguyen  
Examiner  
Art Unit 3731

Vn *VP*  
June 11, 2004



**JULIAN W. WOO**  
**PRIMARY EXAMINER**